

PATENT  
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In re the Application of : Confirmation No. 4336  
Ian E. Kibblewhite, et al. : Group Art Unit 2855  
Application No. 10/528,515 : Examiner: Jonathan M. Dunlap  
Filing Date: October 26, 2005 : (571) 270-1335  
For a Patent for :  
THREAD FORMING FASTENERS :  
FOR ULTRASONIC LOAD :  
MEASUREMENT AND CONTROL : May 25, 2010

INFORMATION DISCLOSURE STATEMENT

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is being filed to advise the U.S. Patent Office of information which may be considered "material to patentability" in examining this Patent Application, in accordance with the provisions of 37 C.F.R. §1.56.

To this end, the U.S. Patent Office is advised of a later-filed U.S. Patent Application, No. 12/226,049 (entitled "System for Dynamically Controlling the Torque Output of a Pneumatic Tool"). An Office Action has since issued for U.S. Patent Application No. 12/226,049, and the following documents are cited in the issued Office Action.

-1-

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U.S. Patents

5,366,026 (Maruyama et al.) - Issued: November 22, 1994  
4,305,471 (Eshghy) - Issued: December 15, 1981  
4,295,377 (Couchman) - Issued: October 20, 1981

U.S. Patent Application Publications

2007/0151740 (Friberg et al.) - Published: July 5, 2007  
2006/0102367 (Etter et al.) - Published: May 18, 2006  
2005/0161241 (Frauhammer et al.) - Published: July 28, 2005  
2003/0173098 (Miner et al.) - Published: September 18, 2003

U.S. Patent Application No. 12/226,049 was derived from an International Application, No. PCT/US2007/008539, having an International Filing Date of April 6, 2007. The following documents are noted for being cited in the Search Report issued during the international phase of International Application No. PCT/US2007/008539.

U.S. Patents

5,018,988 (Kibblewhite et al.) - Issued: May 28, 1991  
4,294,122 (Couchman) - Issued: October 13, 1981  
3,969,810 (Pagano) - Issued: July 20, 1976  
3,774,479 (Lesner) - Issued: November 27, 1973

International Application No. PCT/US2007/008539 claims the benefit of a U.S. Provisional Application, No. 60/789,828, which was filed April 6, 2006. The following documents were cited in the specification of International Application No. PCT/US2007/008539 and U.S. Provisional Application No. 60/789,828.

U.S. Patents

6,990,866 (Kibblewhite) - Issued: January 31, 2006  
6,009,380 (Vecchio et al.) - Issued: December 28, 1999  
5,220,839 (Kibblewhite) - Issued: June 22, 1993  
5,018,988 (Kibblewhite et al.) - Issued: May 28, 1991  
4,899,591 (Kibblewhite) - Issued: February 13, 1990  
4,846,001 (Kibblewhite) - Issued: July 11, 1989

A search was performed prior to filing U.S. Provisional Application No. 60/789,828. The following documents were identified in this search.

U.S. Patents

4,344,138 (Frasier) - Issued: August 10, 1982  
4,316,512 (Kibblewhite et al.) - Issued: February 23, 1982  
4,281,987 (Kleesattel) - Issued: August 4, 1981  
4,281,538 (Dudek) - Issued: August 4, 1981  
4,104,778 (Vliet) - Issued: August 8, 1978

4,074,772 (Jonsson) - Issued: February 21, 1978  
4,043,222 (Dudek) - Issued: August 23, 1977  
4,008,772 (Boys) - Issued: February 22, 1977  
4,006,784 (Dudek) - Issued: February 8, 1977  
3,969,810 (Pagano) - Issued: July 20, 1976  
3,181,672 (Swanson) - Issued: May 4, 1965

U.S. Patent Application Publications

2004/0050567 (Tambini) - Published: March 18, 2004  
2004/0045729 (Lehnert et al.) - Published: March 11, 2004

International Application No. PCT/US2007/008539 was published under the No. WO 2007/117575 on October 18, 2007. A European Patent Application, No. EP 07 754 971.5, was also derived from International Application No. PCT/US2007/008539. A Supplementary Search Report has issued for European Patent Application No. EP 07 754 971.5 and the following documents were cited in this Search Report.

U.S. Patents

5,439,063 (Anders et al.) - Issued: August 8, 1995  
5,220,839 (Kibblewhite) - Issued: June 22, 1993  
5,018,988 (Kibblewhite et al.) - Issued: May 28, 1991  
3,969,810 (Pagano) - Issued: July 20, 1976

Foreign Document

WO 2005/063448 (Atlas Copco Tools AB; Friberg et al.) -  
- Published: July 14, 2005

A copy of WO 2005/063448 has been enclosed with this Information Disclosure Statement. Copies of the above-listed U.S. patent documents have not been enclosed with this Information Disclosure Statement in view of the elimination of this requirement from 37 C.F.R. §1.98(a)(2) (See, Section 609.04(a), Part II(D), of the Manual of Patent Examining Procedure).

Due consideration of the foregoing documents is respectfully requested under 37 C.F.R. §1.56(a)(2). It is further respectfully requested that the Examiner acknowledge consideration of the above-listed documents by initialing the PTO-1449 forms (2) which are enclosed with this Information Disclosure Statement and which list the foregoing documents, and by providing applicants with initialed copies of the enclosed PTO-1449 forms to confirm consideration of the listed documents.

It is recognized that this Information Disclosure Statement is being filed as a submission for an additional request for the continued examination of this Patent Application. However, Section 2001.06(b) of the Manual of Patent Examining Procedure states that:

The individuals covered by 37 CFR 1.56 have a duty to bring to the attention of the examiner, ...information within their knowledge as to other copending United States applications which are "material to patentability" of the application in question... [citing] *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 (7th Cir. 1972)... [and] the prior art references from one application must be made of record in another subsequent application... [citing] *Dayco Prod.*, [infra,] 329 F.3d at 1369, 66 USPQ2d at 1808.

Section 2004 of the Manual of Patent Examining Procedure further indicates that:

It is desirable to call such applications to the attention of the examiner even if there is only a question that they might be "material to patentability" of the application the examiner is considering. See *Dayco Prod., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1365-69, 66 USPQ2d 1801, 1806-08 (Fed. Cir. 2003)....

Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided.


In view of the foregoing, it is submitted that this Information Disclosure Statement is appropriately submitted and duly considered in connection with this Patent Application. It is further respectfully requested that the Examiner reconsider the patentability of the claims which are pending in this Patent Application.

This Information Disclosure Statement is being submitted together with a "Request for Continued Examination (RCE) Transmittal" under the provisions of 37 C.F.R. §1.114. No fee is believed to be necessary for the filing of this

Information Disclosure Statement. In the event that a fee is required in connection with the filing of this Information Disclosure Statement, any necessary fees can be charged to Deposit Account No. 03-2405.

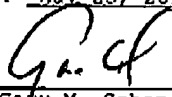
Corresponding action is earnestly solicited.

Respectfully submitted,

  
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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300) on: May 25, 2010.

Date: 5/25/10

  
Gary M. Cohen, Esq.